

### **REMARKS/ARGUMENTS**

The indicated allowability of claims 3-6, 8-14 is noted with appreciation. These claims have not been amended to independent form, pending allowability of parent claims.

Claims 1, 2, 7 have been rejected under 35 U.S.C. 103(a) over Moreau, et al U.S. Patent 5,000,119 and further in view of Almeda U.S. Patent 6,432,029.

The Examiner states that Moreau, et al '119 discloses the claimed invention except that resilient bumpers are not positively disclosed, and that Moreau's device comprises a plurality of stalls 33, each having shoulder bars 53 guidingly locating the shoulders of an animal 18, the animal being aligned along a longitudinal axis defined from head to rump. The Examiner states that the addition of a cushion member resilient bumper is a well-known modification in a device where a body part of a mammal comes into constant contact with a metal bar or member. The Examiner states that Almeda '029 shows an example of the use of resilient bumpers 32, 34, 36 as a cushioning barrier between a metal bar and a user's body, and that Almeda teaches that elements 32, 34, 36 are advantageous as they absorb forces exerted on the user's body, thus enhancing comfort and preventing injury. The Examiner states that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Moreau's milking parlor by adding resilient bumpers to shoulder bars 53 in order to enhance the comfort and prevent injury of the cow using the stall.

### **CLAIM 1**

Claim 1 defines a milking parlor (20) for milking a plurality of mammals (e.g. 22, 24, etc.), comprising a plurality of stalls (26, 28, etc.) having respective shoulder bars (e.g. shoulder bars 32 and 34 for stall 26, and shoulder bars 36 and 38 for stall 28) guidingly locating the shoulders of the mammal in a milking position, the bars having respective

resilient bumpers (e.g. 52, 54, 56, 58) engaging the shoulders in deformable cushioning relation.

### BURDEN OF PRIMA-FACIE SHOWING

It is respectfully submitted that a prima-facie showing has not been made that it is obvious to provide the noted shoulder bars in a milking parlor with resilient bumpers engaging the mammals' shoulders in deformable cushioning relation. References for individual aspects have been cited, including: a) a milking parlor with stalls having shoulder bars for the mammals guidingly locating the shoulders of the mammal in a milking position; and b) resilient bumpers. Is it obvious to provide the resilient bumper in the defined milking parlor?

Is a linking reference necessary, particularly in view of the beneficial advantages and results (as supported in the specification, page 2, lines 4-9, page 3, lines 16-26), or is the mere combination of individually known aspects in the prior art sufficient to meet the requisite prima-facie showing? It is respectfully submitted that a linking reference is necessary. Furthermore, it is respectfully noted that there is no suggestion in the references themselves for combining same to arrive at the defined combination in claim 1.

Is there a nonobvious act of cognition and selection required to arrive at the invention defined in claim 1? It is respectfully submitted that the answer is yes.

Is the simplicity and effectiveness of applicant's solution, notwithstanding the long-felt but unresolved need and motivation for same, surprising in a crowded art such as milking parlors, and is this actually probative of nonobviousness? It is respectfully submitted that the answer is yes.

As noted by the Supreme Court in United States v. Adams, 383 US 39 at 50, 148 USPQ 479, at 483 (1966), a companion case to Graham v. John Deere Company, 383 US 1, 148 USPQ 459 (1966):

"It begs the question. . .to state merely that magnesium and cuprous chloride were individually known battery components. If such a combination is novel, the issue is whether bringing them together as taught [by the inventor] was obvious in the light of the prior art."

The act of selection is a supportable basis for invention, and is not precluded by apparent simplicity, Republic Industries, Inc. v. Schlage Lock Co., 592 F.2d 1963, 200 USPQ 769 (1979) quoting Judge Learned Hand, B.G. Corp. v. Walter Kidde and Co., 79 F.2d 20, 26 USPQ 288 (1935):

"It may be that in certain circumstances the very choice of the elements to be selected is not obvious.",  
Republic, page 778.

Simplicity of a combination makes the task even more difficult.

It is respectfully submitted that the burden of factually supporting a prima-facie conclusion of obviousness is not present. There is no showing, suggestion, or even hint of combining the references as proposed, nor to arrive at the combination defined in claim 1. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination, MPEP 2143.01. None of the references suggest the desirability of the proposed combination. It is respectfully submitted that there must be some motivation in the prior art itself for combining or attempting to combine the references, particularly in view of the significant advantages resulting from applicant's combination as noted above, and the resulting enablement afforded thereby.

Further, in direct rebuttal of the Examiner's position, applicant respectfully notes In re Lee, 61 USPQ (2nd) 1433, CAFC 2002, noting that the question of obviousness

requires evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. The CAFC further elaborated on this matter by explaining that the test cannot be met simply by saying that the basis for combining the references comes from "common knowledge" or is "common sense". The Examiner's position thus is not sustainable.

In re Kotzab, 55 USPC 2nd 1313, CAFC 2000, the Court commented on the need for avoiding a "hindsight syndrome". This is particularly important in cases where the very ease to which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher".

#### COMBINABILITY OF REFERENCES AND REASONABLE TEACHINGS THEREOF

The Examiner is respectfully requested to consider In re Dembiczak, 50 USPQ 2nd 1614 (1999), wherein the invention at issue was a large trash bag made of orange plastic and decorated with lines and facial features, allowing the bag, when filled with trash or leaves to resemble a Halloween-style pumpkin or jack-o-lantern, and which was rejected over a combination of the references showing traditional trash bags and decorated jack-o-lantern or pumpkin bags. The Court notes, page 1616, that an analysis under §103 begins with the phrase "at the time the invention was made" to guard against entry into the "tempting but forbidden zone of hindsight", and that, page 1617, "measuring a claimed invention against the standard established by §103 requires the oft-difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field", and to avoid the temptation which may otherwise prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher". Further, the Court in Dembiczak, notes page 1617, that the "case law makes clear that the best defense against the subtle but powerful attraction of a

hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references". The Court further notes, page 1617, that "combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight".

It is respectfully submitted that in the present case, the rejection does not identify any suggestion, teaching or motivation to combine the references as proposed.

As noted by the Court in Dembiczak, page 1618, "yet this reference-by-reference, limitation-by-limitation analysis fails to demonstrate how the Holiday and Shapiro references teach or suggest their combination with the conventional trash or lawn bags to yield the claimed invention", so too the present rejection reference-by-reference and limitation-by-limitation analysis fails to demonstrate how the references teach or suggest their combination.

#### ACT OF COGNITION OR SELECTION

The presence in the prior art of milking parlors with stalls having shoulder bars guidingly locating the shoulders of the mammal in a milking position, and the presence in the prior art of resilient bumpers, yet the non-recognition of applicant's solution is respectfully submitted as demonstrative evidence of nonobviousness. This non-recognition is particularly conspicuous in a crowded mature art, and is believed probative that applicant's solution involves a nonobvious act of cognition and selection required to arrive at such solution not previously recognized in the art.

The Examiner is respectfully requested and earnestly entreated to consider that simplicity in application does not preclude a finding of nonobviousness. Those in the art have not recognized nor been motivated to applicant's combination, notwithstanding the known use of individual aspects. It may deceptively seem apparent to now combine individual aspects as shown by applicant, but only with the aid of hindsight. There does not appear to be any suggestion of any such marriage or combination in the art to arrive at the

present solution in the defined combination, nor does there appear to be a reference which bridges the gap to applicant's invention. The pieces of the puzzle were present and known for many years, but never assembled together until applicant's invention. It is surprising that such a simple yet desirable combination has apparently gone unrecognized in the art for so long. The absence of such suggestion is particularly conspicuous in a crowded art, especially in view of the age of the art and the longstanding non-recognition of the present solution, and is believed probative of non-obviousness.

It is respectfully submitted that the cognition, selection and application in the present invention is novel and nonobvious and is not recognized in the prior art. The invention requires linking association involving a cognitive step not suggested previously in the art.

Applicant recognizes that it is a difficult if not impossible task to completely purge oneself of hindsight when attempting to place oneself in the shoes of the legal ghost called the ordinarily skilled artisan. Simplicity of a combination makes the task even more difficult. As noted above by the Supreme Court *It begs the question. . .to state merely that magnesium and cuprous chloride were individually known battery components. If such a combination is novel, the issue is whether bringing them together as taught [by the inventor] was obvious in the light of the prior art.* The act of selection is a supportable basis for invention, and is not precluded by apparent simplicity. As noted by Judge Learned Hand, *it may be that in certain circumstances the very choice of the elements to be selected is not obvious.*

## CLAIM 2

Regarding claim 2, the Examiner states that Almeda's resilient bumpers are considered to flex outwardly away from the longitudinal axis when the cow presses against them, and, since Moreau's bars 53 pivot, the stall can accommodate various sized cows and permit longitudinal movement of the cows when they are in the stalls.

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In response, applicant respectfully notes that claim 2 requires that the bumpers (52, 54) themselves flex laterally outwardly (68, 70, Figs. 6, 11) away from the axis (60) and also permit continued longitudinal movement (arrow 66) of the mammal along the axis (60) during the lateral outward flexing (68, 70).

Even if the references are combined as proposed, the resultant combination still does not satisfy the limitations of claim 2. In such resultant combination of references, as noted by the Examiner, the stall can accommodate various sized cows and permit longitudinal movement of the cows when they are in the stalls because of the pivotal movement of Moreau's bars 53, as stated by the Examiner at the top of page 3 of the Office Action. In contrast, claim 2 particularly requires that this function be performed by the bumpers. Consideration and allowance of claim 2 is earnestly solicited.

#### CLAIM 7

Claim 7 defines in combination a resilient bumper for a milking parlor, and is believed allowable for the reasons noted above in conjunction with claim 1.

It is believed that this application is in condition for allowance with claims 1-14 and such action is earnestly solicited.

Respectfully submitted,

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